

09/544,682

**REMARKS**

The present Response is filed in reply to the Office Action of July 8, 2004.

Claims 1 through 32 are presently pending in the present Application and the Examiner has declared that claims 1 through 21 and 26 through 32 are allowed, for which the Applicant thanks the Examiner.

The Examiner has, however, rejected claims 22 through 25 under 35 U.S.C. 102 over U.S. Patent No. 6,389,538 to Gruse et al. for a SYSTEM FOR TRACKING END-USER ELECTRONIC CONTENT USAGE, hereafter referred to as "Gruse et al. '538", for the reasons stated in the Office Action of July 8, 2004.

The Applicant respectfully disagrees with the Examiner's rejection of claims 22 through 25 and respectfully traverses the stated rejections of claims 22 through 25 for the following reasons.

First briefly considering the relationships between claims 22, 23, 24 and 25, it will be noted that claim 23 is dependent from claim 22 and thereby incorporates all recitations and limitations of claim 22 by dependency therefrom. Claim 25 is in turn dependent from claim 24, and thus incorporates all recitations and limitations of claim 24 by dependency therefrom.

First considering claims 22 and 23, claim 22 describes a method for generating an installable executable program which will, in turn, install a digital content file (the DCF) and associated licensing and access control elements and functions (the FACM and DLDB) on an end user system to provide controlled, licensed access to the licensed contents of the content file by the end user system.

According to the present invention as recited in claim 22, access to the licensed contents of the content file will be controlled by the access control elements embedded with the content file, and will be according to the license terms and provisions embedded with the content file. The contents of the content file, the access control mechanism and the license terms and provisions thereby together comprise a single, integrated entity that may be download into an end user system as an entity and that locally contains and comprises all of the elements and functions necessary to control access to the contents of the content file, including a graphical user interface (GUI) to initiate and control the installation of the content file and associated access control and license mechanisms.

Lastly with regard to claim 22, it must be noted that claim 22 recites an embodiment of the present invention wherein the contents of the content file are comprised of data rather than, for example, executable code. In the embodiment of claim 22, therefore, and for example, the digital content file may contain information and data stored in a digital format, such as music,

09/544,682

videos, pictures, movies and other non-executable digital files, so that the method of claim 22 provides a secure and controlled means for distributing such contents.

Claim 23, which is dependent from claim 22 and thus incorporates all recitations and limitations of claim 22, is directed to the method of claim 22 wherein the contents of the content file are comprised of an executable program or programs, such as application programs, games, business utilities, and so on.

In addition to the method steps and mechanisms recited in claim 22, therefore, the method of the present invention as recited in claim 23 includes additional adaptations and steps for controlling of and access to executable program contents. For example, the method of the present invention as recited in claim 23 includes embedded application program interfaces (APIs) to control access to the associated licensing and access control elements and functions (the FACM and DLDB). In another aspect of the invention, the executable content files are reconstructed at runtime to generate a resultant executable program that is managed by the file access control manager (FACM), so that an executable program in a content file is never "unlocked" into an un-secured state, but is instead dynamically generated and executed and is returned to its secured state after being run.

It must be further noted that these access mechanisms are based upon an "adaptive fingerprint" authentication mechanism, and that all aspects of the licensed use of the content files are validated "locally" on the user system and does not require, for example, an internet connection to a remote site for the use validation functions.

It will therefore be apparent that there are a number of fundamental distinctions between the teachings of Gruse et al. '538 and the present invention as recited in claims 22 and 23.

For example, and in complete and fundamental contrast from the present invention as recited in claim 22 and thus in claim 23, the Gruse et al. '538 system not only includes not only a distributor site and the end user site, but further relies upon the use of a third "clearinghouse" site to which the end user site must refer in order to determine and obtain access to the licensed file contents and where the licensing and file access control operations are in fact carried out. In complete contrast from the Gruse et al. '538 system, the method of the present invention as recited in claims 22 and 23 does not use and is not dependent upon access to a clearinghouse site but instead performs all file content access and license control functions locally, that is, solely within the end user site.

This fundamental distinction between the present invention as recited in claims 22 and 23 is further reflected in other aspects of the two systems. For example, in the Gruse et al. '538 system the licensed contents and the mechanisms and information for controlling access to the licensed contents are and must be distributed across the clearinghouse site as well as the end

09/544,682

user site and the distribution site. In the method of the present invention, and in complete contrast from the Gruse et al. '538 system, the licensed contents, the access control mechanism and the license terms and provisions together comprise a single, integrated entity that may be download into an end user system as an entity and that locally contains and comprises all of the elements and functions necessary to control access to the contents of the content.

It should also be noted that in yet another fundamental distinction between the present invention and the Gruse et al. '538 system is that the Gruse et al. '538 system requires the downloading of a decryption key from the clearinghouse site and the use of the decryption key at the end user site to decrypt the content file in order to allow the local site to access the contents of that file. In fundamental contrast from Gruse et al. '538 system, and because the method of the present invention is self-contained and performs all functions locally, that is, at the end user site, the method of the present invention does not require the use of externally provided decryption keys. The method of the present invention instead requires only the locally resident license data and file access content manager to validate access to the content file and to dynamically interpret the secure contents of the file at each access.

It is therefore the belief and position of the Applicant that the present invention is fully and patentably distinguished over and from the teachings and suggestions of Gruse et al. '538 under the requirements and provisions of both 35 U.S.C. 102 and 35 U.S.C. 103 for the reasons discussed above.

The Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claims 22 and 23 over Gruse et al. '538 under the requirements and provisions of either or both of 35 U.S.C. 102 and 35 U.S.C. 103, and the allowance of claims 22 and 23.

Next considering claims 24 and 25, as described herein above, claim 25 is dependent from claim 24 and thereby incorporates all recitations and limitations of claim 24.

Upon reviewing claim 24 in light of Gruse et al. '538 and the Examiner's comments, the Applicant has concluded that claim 24 is fully distinguished over and from the teachings of Gruse et al. '538 under 35 U.S.C. 102 and 35 U.S.C. 103 by reciting a digital content file in which the licensed contents and the access control mechanism, including the license terms and provisions, together comprise a single, integrated entity that may be download into an end user system as an entity and that thereby locally contains and comprises all of the elements and functions necessary to control access to the contents of the content.

The present invention as recited in claim 24 is thereby fully and fundamentally distinguished over and from Gruse et al. '538 for the reasons discussed herein above. That is, a content file of the Gruse et al. '538 system does not comprise a single, integrated entity locally

09/544,682

contains and comprises all of the elements and functions necessary to control access to the contents of the content but instead is a mechanism requiring the use of a separate clearinghouse site, completely separate and apart from the end user site, where the file access functions are actually performed.

In order to advance the prosecution and allowance of claims 24 and 25, however, the Applicant herein above submits amendments to claim 24 that incorporate the essentially recitations of claims 22 into claim 24, thereby more explicitly setting out the distinctions of the present invention over the teachings of Gruse et al. '538.

It is therefore the belief and position of the Applicant that claim 24 is now more fully and explicitly distinguished over and from the teachings of Gruse et al. '538 and, as a result, that claim 24 is fully and patentably distinguished and from the teachings of Gruse et al. '538 under the requirements and provisions of both 35 U.S.C. 102 and 35 U.S.C. 103.

It is further the belief and position of the Applicant that because claim 25 is dependent from claim 24 and thereby incorporates all recitations and limitations of claim 24, claim 25 is now more fully and explicitly distinguished over and from the teachings of Gruse et al. '538 and, as a result, that claim 25 is fully and patentably distinguished and from the teachings of Gruse et al. '538 under the requirements and provisions of both 35 U.S.C. 102 and 35 U.S.C. 103.

The Applicant therefore respectfully requests that the Examiner reconsider and withdraw all rejections of claims 24 and 25 over Gruse et al. '538 under the requirements and provisions of both 35 U.S.C. 102 and 35 U.S.C. 103, and the allowance of claims 24 and 25 as amended herein.

Lastly, the Applicant has considered the additional prior art made of record by the Examiner as being pertinent to the present Application but which was not cited by the Examiner in rejection of the claims. The Applicant concurs with the Examiner that while the cited art may have some pertinence to the present Application, the cited prior art does not disclose or suggest the present invention as recited in the claims to those of ordinary skill in the arts under either of 35 U.S.C. 102 and 35 U.S.C. 103.

In summary, it is therefore the belief and position of the Applicant that the present invention as recited in new claims 22 through 25 is fully and patentably distinguished over and from all of the cited prior art, and the Applicant accordingly respectfully requests allowance of the present Application with claims 22 through 25 as amended herein above.

If any further amendment to this application is believed necessary to advance prosecution and place this case in allowable form, the Examiner is courteously solicited to contact the undersigned representative of the Applicant to discuss the same.

09/544,682

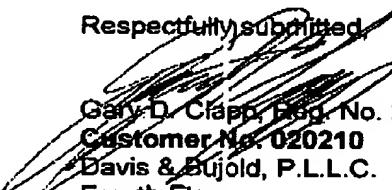
In view of the above amendments and remarks, it is respectfully submitted that all of the raised rejection(s) should be withdrawn at this time. If the Examiner disagrees with the Applicant's view concerning the withdrawal of the outstanding rejection(s) or applicability of the JP '086 and/or Japan Robotics references, the Applicant respectfully requests the Examiner to indicate the specific passage or passages, or the drawing or drawings, which contain the necessary teaching, suggestion and/or disclosure required by case law. As such teaching, suggestion and/or disclosure is not present in the applied references, the raised rejection should be withdrawn at this time. Alternatively, if the Examiner is relying on his/her expertise in this field, the Applicant respectfully requests the Examiner to enter an affidavit substantiating the Examiner's position so that suitable contradictory evidence can be entered in this case by the Applicant.

In view of the foregoing, it is respectfully submitted that the raised rejection(s) should be withdrawn and this application is now placed in a condition for allowance. Action to that end, in the form of an early Notice of Allowance, is courteously solicited by the Applicant at this time.

The Applicant respectfully requests that any outstanding objection(s) or requirement(s), as to the form of this application, be held in abeyance until allowable subject matter is indicated for this case.

In the event that there are any fee deficiencies or additional fees are payable, please charge the same or credit any overpayment to our Deposit Account (Account No. 04-0213).

Respectfully submitted,

  
Gary D. Clapp, Reg. No. 29,055  
Customer No. 020210  
Davis & Bujold, P.L.L.C.  
Fourth Floor  
500 North Commercial Street  
Manchester NH 03101-1151  
Telephone 603-624-9229  
Facsimile 603-624-9229  
E-mail: [patent@davisandbujold.com](mailto:patent@davisandbujold.com)